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REMARKS

Claims 1-21 are rejected. Claims 1, 9, 11-14, 16, 18, 19, and 21 are amended. Claim 21 is cancelled. Claims 1-20 remain pending.

Claim 1 is amended to recite an end effector, and to recite that the end effector is advancable relative to the housing. Support for the amendment is provided by Figures 3, 4, and the associated portions of the detailed description. Claim 9 is amended to correct a spelling error. Claim 11-14 are amended to correct dependency from Claim 1 to Claim 10. Claim 16 is amended to recite a flexible shaft extending intermediate the handle and the end effector, as shown and described with respect to Figures 2 and 3. Claims 18 and 19 are amended to conform those Claims to amended Claim 16. No new matter is added.

112 Rejection:

Claims 12 and 13 are rejected as indefinite. It is respectfully urged that the amendment of Claims 12 and 13 to depend from Claim 10, rather than Claim 1, address this rejection.

102 Rejection:

Claims 1-4 are rejected as anticipated by Stone et al. US 6533797. This rejection is improper for at least the following reasons.

Regarding amended Claim 1, it is respectfully urged that the Stone reference does not teach a surgical device comprising a housing with an actuator, and an end effector, where the housing is adapted for gripping in the palm of a user's hand, where the actuator is operable by one or more fingers of the same hand without the use of either of the thumb and index finger of the hand; and wherein the end effector is advancable relative to the housing. For instance, it is not seen how the tube 37 of Stone would permit advancement of an end effector relative to the body 32 of Stone.

Accordingly, withdrawal of the rejection of Claims 1-4 is requested.

103 Rejections:

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Claims 5-6, 10-13, and 16-20 are rejected as being unpatentable over Stone et al. in view of US 6,786,865 to Dhindsa. This rejection is respectfully traversed for at least the following reasons.

With respect to Claims 5-6, it is respectfully urged that the rejection is improper for the reasons set forth above regarding amended Claim 1, from which Claims 5 and 6 depend. Further, the Examiner admits that Stone does not teach or suggest a device for holding the handle to the hand where the device does not require active gripping by any fingers of the hand. However, the Examiner maintains that Dhindsa teaches an "analogous device" wherein an endoscope handle assembly is releasably secured to the hand.

It is respectfully urged that the Examiner has not made out a prima facie case of obviousness. A prima facie case of obviousness requires that three basic criteria be met: 1. A suggestion or motivation in the prior art to modify or combine reference teachings; 2. A reasonable expectation of success; and 3. The references when combined must teach or suggest all the claim limitations.

It is respectfully urged that the Examiner has not provided the motivation in the prior art for making the combination of Stone et al. with Dhindsa. The Examiner merely concludes that Dhindsa is an "analogous device", without further explanation or support, and it is respectfully urged that this characterization of Dhindsa as an "analogous device" does not meet the requirement to show motivation in the prior art.

Further, even if one combines Stone with Dhindsa, it is respectfully urged that the resulting combination would not teach all the claim limitations. It is respectfully urged that Stone and Dhindsa combined do not teach or suggest an end effector which can be advanced relative to a housing, as recited in amended Claim 1.

With respect to Claim 10 as originally filed, it is respectfully urged that the Examiner does not appear to address this Claim in the Examiner's office action. On page 3 of the Office Action there is a heading that includes Claim 10. However, none of the explanation provided under this heading and which is provided on pages 3 or 4 seems to address Claim 10. In particular, it is not seen where the Stone or Dhindsa references teach or suggest a device including an end effector operatively associated with a distal end of a flexible member; and a handle operatively associated with the proximal end of the flexible member;

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where the handle comprises an actuator for operating the end effector through the flexible member, where the handle is adapted to be gripped by a single hand, and where the actuator is adapted to be operated by the same hand holding the handle while the thumb and index finger of the same hand are free to grip and advance the flexible member.

On page 4, under the heading "In regards to claims 12 and 13" the Examiner does refer to a flexible member, and goes on to mention "Caymen". The Examiner has included in the references made of record a "Clayman" US 5,152,278. However, it is respectfully urged that the Examiner has not applied Clayman. Accordingly, it is respectfully urged that the Examiner should allow Claim 10 and all claims depending therefrom, or alternatively, if the Examiner intends to combine another reference with Stone and/or Dhindsa, the Examiner should provide a nonfinal rejection so that the Applicant understands the basis for the Examiner's rejection and has a full and fair opportunity to respond.

With respect to Claim 11, the Examiner states that Stone et al. discloses a surgical instrument wherein the end effector is a cutting blade 35. However, Claim 11 recites an end effector selected from the group consisting of a biopsy forceps, grasping forceps, surgical scissors, extractors, washing pipes, needle injectors, non energized snares, and electrosurgical snares. The Examiner is requested to explain how the blade 35 teaches the subject matter recited in Claim 11.

With respect to Claims 12 and 13, the Examiner admits that Stone et al. is silent with respect to a flexible member having a length of at least .5 meter. It is respectfully urged that Stone et al. does not teach or suggest a flexible member as recited in Claim 10 or Claims 12 and 13, little less a flexible member having a length of at least .5 meter. The Examiner also refers to "Caymen" (but does not appear to apply Clayman in the rejection). The Examiner is respectfully requested to clarify if Clayman, US 5,152,278 is being referred to, and if that reference is being combined with Stone et al. or any other reference.

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With respect to amended Claim 16, the Examiner is respectfully requested to explain what in Stone et al. or Dhindsa teaches or suggests a flexible shaft as recited in Claim 16. Withdrawal of the rejection is requested.

With respect to Claims 7-8 and 14-15 (and presumably Claims 16-19), the Examiner states that it would be obvious to one skilled in the art to include directions with the apparatus of Stone to insure proper usage, and because according to the Examiner it is well known to include instructions with any device. This rejection is respectfully traversed for the following reasons.

First, the rejection of Claims 7-8 is improper for the reasons set forth above with respect to independent Claim 1, and the rejection of Claims 14-15 is improper for the reasons set forth above with respect to Claim 10.

Additionally, even if one assumes the Examiner is correct in stating that it is well known to include instructions to insure proper usage, it is respectfully urged that the specific instructions recited would not be obvious. For instance, Claim 19 recites the set of instructions includes instructions to use the thumb and index finger of the hand holding the handle to grasp the flexible shaft. It is respectfully urged that nothing in Stone et al. or Dhindsa et al. would teach or suggest a flexible shaft as recited, or grasping a flexible shaft with the same hand holding a handle as recited, or grasping a flexible shaft with a thumb and index finger.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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